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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,083	04/27/2001	Oliver Nickel	Beiersdorf 721-KGB	9696

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,083

Applicant(s)

NICKEL, OLIVER

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 081403 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 9/29/03. Applicant's amendments to claims 1, 7 and 11 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.
4. It is noted that the newly filed information disclosure sheet acknowledges the co-pending application no. 09/844,084. However, the Examiner notes that the co-pending application no. 09/431,849 is still improperly absent from the record of the present application, and correction is required.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

More particularly, in newly amended claim 11, line 2, the phrase "line tape" is absent from the Specification. Also, it appears that a proper amendment should include the canceled term "fine", so as to be consistent with original disclosure.

Claim Rejections - 35 USC § 112

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite of the amendment, the Examiner notes that the claims are still replete with vague and indefinite terms. For example:

In claim 1, line 3, and throughout, the term "composition" is vague and indefinite, because clearly a "composition" cannot be applied to a backing. The Examiner suggests to change the term "composition" to --layer--.

In claim 1, line 4, and throughout, the phrase "masking material" appears vague and indefinite, in particular, how would one of ordinary ^{skill} in the art to distinguish the difference between "masking material" and "masking sheet" (see line 7)? Clarification is requested.

In claim 4, line 3, the phrase "capable of" is vague and indefinite. It has been held that a recitation that an element is "capable of" (or "adapted to") performing a function is not a positive limitation but only requires the ability to so. As such, it does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

For claim 11, as set forth above, the Examiner suggests the scope of the tape should be consistent with original filing, and it appears that the cancellation of "fine" at line 2 is improper, because it renders the scope, i.e., the width, unduly vague and indefinite, which may also be considered to be unduly broad under 35 U.S.C. 112, first paragraph.

Terminal Disclaimer

7. The terminal disclaimer filed on 8/13/2003 is not proper and has not been accepted because attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number. Additionally, the Examiner notes that Applicant has stated terminal disclaimers over co-pending application no. 09/431,849 and co-pending application no. 09/844,084 will be submitted (Remarks, page 10), however, the terminal disclaimer filed on 8/13/2003 does not include the co-pending application no. 09/431,849.

Response to Amendment

8. Claims 1-3, 5-7, 10, 13-15, 17 and 19-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9, 11 and 12 of copending Application No. 09/431849, substantially for the reasons set forth in section 7 of Paper No. 15, together with the following additional observations. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Applicant's response arguing that the claims are not co-extensive with application no. 09/431,849, because the instant invention comprises a flexible sheet, whereas application no. 09/431,849 requires a paper backing, appears persuasive. As such, the double patenting rejection is now repeated under the judicially created doctrine of obviousness-type double patenting, since it is known that a paper backing is inherently

flexible. As such, the instantly claimed invention comprising a flexible sheet is believed to be either inherently disclosed by the application no. 09/431,849, or an obvious selection to one of ordinary skill in the art of adhesive sheet backing.

Additionally, the Examiner notes that the terminal disclaimer filed on 8/13/2003 does not include the co-pending application no. 09/431,849. Appropriate correction is required.

9. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9, 11 and 12 of copending Application No. 09/431849, substantially for the reasons set forth in section 7 of Paper No. 15, together with the following additional observations.

As set forth above, the terminal disclaimer filed on 8/13/2003 is not proper and has not been accepted. Appropriate correction is required.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Art Unit: 1771

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DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300

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Daniel Zinker